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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,483	11/11/2003	David J. Austin	Y03-093	5150

7590 07/19/2005

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EXAMINER

OWENS, AMELIA A

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,483

Applicant(s)

AUSTIN ET AL.

Examiner

Amelia A. Owens

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 11, 14, 20 and 24 is/are rejected.
- 7) ☒ Claim(s) 2-6, 8-10, 12, 13, 15-19, 21-23, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

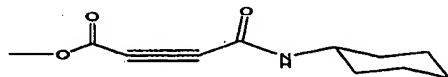
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DETAILED ACTION

Claims 1-30 are pending. Drawings were filed with the application.

Election

Applicant's election with traverse of Group I, claims 1-26 (in part), species

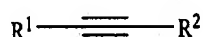


in the reply filed on May 5, 2005 is acknowledged. The traversal is on the ground(s) that compounds share a single structural feature (acetylenic group) having two substituents which have a common utility; and that MPEP 803 is proper if the inventions are independent and a serious burden to the examiner. This is not found persuasive because a **limited search** of the acetylenic compounds yielded 766 references in caplus ALONE. Note other databases have not been searched. *Please note that at this point the full scope of the acetylenic compounds has not been searched.* See attached search of structure 10/705483y. The variables on the acetylenic group contain heteroaryl and heterocyclic groups that are properly classifiable in 540, 544, 546, 548, 514; amine groups properly classifiable in 564 and 514. A full examination of the claims of this application does not fall within three subclasses. Those subclasses were cited in the restriction by way of example. Moreover, groups falling within class 549, *for example*, would not be anticipated or obvious over groups falling in any of 564, 540, 546, etc., and vice versa. This further supports the independence of the inventions despite the shared single structural feature (acetylenic group). For this reason, the restriction is proper, the claims are directed to independent inventions and there would be a serious burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

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Species of the formula where R1 is H, OH, F, Cl, Br, I a C1-C6 optionally substituted alkyl or alkenyl group, an optionally substituted aryl group or a C(O)-Ra group; Ra is a H, OH, C1-C10, optionally substituted alkyl or alkenyl group, an optionally substituted O-(C1-C7 alkyl group) or O-aryl group, an amine group which is optionally substituted with at least one C1-C10 alkyl group which may be optionally substituted, or a single optionally substituted aryl group, biphenyl group; R2 is C(O)Rb group; Rb is a H, OH, C1-C10, optionally substituted alkyl or alkenyl group, an optionally substituted O-(C1-C7 alkyl group) or O-aryl group, an amine group which is optionally substituted with at least one C1-C10 alkyl group which may be optionally substituted, or a single optionally substituted aryl group, biphenyl group --- have been examined.



It is noted that the elected species is outside the scope of the claims. Please note the definition of Rb does not include cycloalkyl groups. The species is supported by the specification as it appears on page 24.

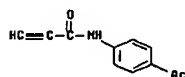
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

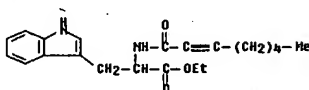
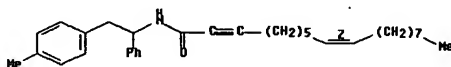
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7, 11, 14, 20, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller CA 65:38326 that teach species according to the invention as a pharmaceutical. Note R1 is hydrogen; R2 is C(O) Rb where Rb is amine optionally substituted by single optionally substituted aryl.



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Claims 1, 7, 11, 14, 20, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kathawala CA 93:94825 which teach species according to the invention as a pharmaceutical. Note R1 is optionally substituted alkenyl or alkyl; R2 is C(O) Rb where Rb is amine optionally substituted by at least one alkyl group which may be optionally substituted. Two species are cited for example only, others appear in the reference.



Claims 2-6, 8-10, 12, 13, 15-19, 21-23, 25, 26 are not included as they are directed to compounds where R1 is C(O)Ra that is outside the scope of both reference.

Claims 2-6, 8-10, 12, 13, 15-19, 21-23, 25, 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Please note the claims need to be limited to the elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMELIA AVERILL OWENS
PRIMARY EXAMINER
Au 1625